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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/537,885 | 06/07/2005 | Benoit Agnus | FR 020137 | 7222 |

65913 7590 11/14/2008
NXP, B.V.
NXP INTELLECTUAL PROPERTY DEPARTMENT
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

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| EXAMINER |
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PHAM, TUAN

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| ART UNIT | PAPER NUMBER |
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2618

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| NOTIFICATION DATE | DELIVERY MODE |
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11/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/537,885 | Applicant(s) AGNUS ET AL. | |
| | Examiner TUAN A. PHAM | Art Unit 2618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 06/21/2007 have been fully considered but they are not persuasive.

In response to applicant's remark on page 5, Applicant argues that Examiner has fails to combine Henriksson and Asam, and Applicant also argues that Henriksson fails to teach testing of integrated circuit as recited in claims 1, 5, and 8.

In response to applicant's arguments, Examiner respectfully disagrees with the applicant's argument. It appears that Applicant is attacking individual merits of Henriksson and Asam and concludes that there is no impetus to combine them. However, the 103 rejection is in consideration the combination of references as a whole. One cannot show non-obviousness by attacking references individually. In re Keller, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art. In re Bozek, (CCPA) 163 USPQ 545. The question in a rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. In re Richman, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Asam as a secondary teaching is not to combine its structural features into Henriksson's structural, but rather to use the teaching of Asam to combine with teaching of Henriksson to meets the claimed invention. Furthermore, the Applicant's invention is

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directed to test the transmission channel in the integrated circuit, and further include the tester. Henriksson teaches a test device for testing the transmitter and receiver which can be integrated microcircuit (see page 2, ln.6-8), and the test unit can be integrated directly into a microcircuit with the transceiver (see [0026]). On the other hand, Asam teaches wireless components that can be modify in the test device. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Henriksson and Asam.

For the reasons above, the 103 rejections as set forth in the last Office Action stand.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henriksson, Markku (WO 02/13427 A1, hereinafter, "Henriksson") in view of Asam et al. (Patent No.: US 6,853,836, hereinafter, "Asam").

Regarding claims 1, 5, and 8, Henriksson teaches an integrated circuit comprising a signal transmission channel (TX) including radio frequencies and an integrated tester (TEST) intended to test radio characteristics of said integrated circuit (see figure 2, transmitter 100, test module 200, [0005, 0012]).

It should be noticed that Henriksson fails to teach first means (COUPL) for recovering a part of the signal generated by the transmission channel (TX) at a first frequency (F0), second means (M) for converting said recovered signal from the first frequency (F0) into a second frequency (F1), an amplifier for amplifying said signal at this second frequency (F1), and a rectifier (R) for rectifying said signal. However, Asam teaches first means (connected between the output of AM and input at PV) for recovering a part of the signal generated by the transmission channel (TX) at a first frequency (RF signal), second means (mixer M1) for converting said recovered signal from the first frequency (RF signal) into a second frequency (IF signal), an amplifier for amplifying said signal at this second frequency (amplifier PR for amplify the IF signal), and a rectifier (rectifier SG2) for rectifying said signal (see col.6, ln.1-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Asam into view of

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Henriksson in order to provide a low energy needs for the device as suggested by Asam at col.1, ln.29-31.

Regarding claims 2, 6, and 9, Asam further teaches detection means for detecting the validity of the signal generated by the transmission channel (see frequency detector PFD, col.6, ln.1-2).

Regarding claims 3, 7, and 10, Asam further teaches a filter for filtering harmonics signal (see filter TP).

Regarding claim 4, Asam further teaches the first frequency (RF) is a radio frequency and the second frequency (IF) is a low frequency (see col.6, ln.1-45).

Regarding claim 11, Claim 11 is rejected the same reason of claim 8.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Pham whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TUAN A PHAM/

Primary Examiner, Art Unit 2618

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